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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/771,055	02/03/2004	Reinhard Heinrich Hohensee	15962.0006USD1/IBMN.004US	1532
23552	7590	03/29/2011		
MERCHANT & GOULD PC P.O. BOX 2903 MINNEAPOLIS, MN 55402-0903			EXAMINER KIM, PAUL	
			ART UNIT 2169	PAPER NUMBER
			MAIL DATE 03/29/2011	DELIVERY MODE PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary	Application No. 10/771,055	Applicant(s) HOHENSEE ET AL.	
	Examiner PAUL KIM	Art Unit 2169	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 20 January 2011.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 27-32 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 27-32 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____ |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

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DETAILED ACTION

1. This Office action is responsive to the following communication: Amendment filed on 20 January 2011.
2. Claims 27-32 are pending and present for examination. Claims 27 and 32 are in independent form.

Response to Amendment

3. No claims have been amended.
4. Claims 1, 5-7, 9-11, 13-17, and 26 have been further cancelled.
5. Claims 27-32 have been added.

Claim Objections

6. **Claim 29** is objected to because of the following informalities: the instant claim ends in a semi-colon. Appropriate correction is required.

Claim Rejections - 35 USC § 112

7. The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.
8. **Claims 27-32** are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the enablement requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to enable one skilled in the art to which it pertains, or with which it is most nearly connected, to make and/or use the invention.

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9. **As per claims 27-32**, the Examiner notes that the functional terms "downloading" and "capturing" are analogous in functionality within the art. Although the claims are interpreted in light of the specification, limitations from the specification are not read into the claims. See *In re Van Geuns*, 988 F.2d 1181, 26 USPQ2d 1057 (Fed. Cir. 1993). In the instant case, wherein the downloading of an object would result in the capturing of said object, it is noted that said functionalities of both "downloading" and "capturing" are indistinguishable. Accordingly, the Examiner notes that wherein the downloading of an object and the capturing of said object are not distinguishable, it is unclear as to how an object may be downloaded yet not captured. Accordingly, this limitation presents a functional conflict which precludes the enablement of the instant invention. Therefore, prior art has not be applied to the instant limitation for the purposes of examination.

10. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

11. **Claim 27** is rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. The Examiner notes that it is unclear as to distinguishable features implicitly and/or explicitly referenced by "a resident object." Further clarification is required as to the location of "a resident object."

12. **Claim 28** is rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. Specifically, lines 6 and 8 recite "a resident globally-unique network OID." It is unclear whether these are to be the same as or different from each other.

Additionally, lines 4-5 recite "a globally-unique network OID." It is unclear whether these are to be the same as or different from each other.

13. **Claim 29** is rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

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Specifically, lines 3-4 recite "a resident globally-unique network OID." It is unclear whether these are to be the same as or different from each other.

14. **Claim 30** is rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. Specifically, lines 3-4 recite "a resident globally-unique network OID." It is unclear whether these are to be the same as or different from each other.

15. **Claim 31** is rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. Specifically, line 4 recites "capturing the object by OID when the OID." It is unclear whether these are to be the same as or different from the prior references to "the globally-unique network OID" recited within the instant claim.

Additionally, the instant claim recites the term "MDR". It is unclear and indefinite as to what the aforementioned term "MDR" is to represent. Appropriate correction is required.

Claim Rejections - 35 USC § 101

16. **Claims 27-32** are rejected under 35 U.S.C. 101 because the claimed invention is directed to non-statutory subject matter. Claims 27-32 are directed to a method for processing referenced objects and fail to (1) be tied to another statutory class or (2) transform underlying subject matter to a different state or thing. Accordingly, the instant claims would not qualify as a statutory process since said claims would be directed to purely mental steps. To qualify under 35 U.S.C. 101 as a statutory process, the claim should positively recite the other statutory class (the thing or product) to which it is tied or positively recite the subject matter that is being transformed.

Response to Arguments

17. Applicant's arguments with respect to the claim rejections under 35 U.S.C. 102 have been considered but are moot in view of the new ground(s) of rejection.

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18. The Examiner further notes that the absence of a prior art application in the instant case should not be construed as the instant claims being allowable over the prior art. It is noted that the instant claim rejections under 35 U.S.C. 112 and 35 U.S.C. 101 should be addressed so as to provide a representation of an enabled invention.

Conclusion

19. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

20. Any inquiry concerning this communication or earlier communications from the examiner should be directed to PAUL KIM whose telephone number is (571)272-2737. The examiner can normally be reached on M-F, 9am - 5pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Tony Mahmoudi can be reached on (571) 272-4078. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/Paul Kim/

Paul Kim
Examiner, Art Unit 2169

/PK/